

Appl. No. 09/720,180
Atty. Docket No. CM1987Q
Amdt. dated 11/14/2003
Reply to Office Action of 07/16/2003
Customer No. 27752

REMARKS

Claims 1-6 and 10-12 are rejected under 35 USC §112, first para., as containing new matter. Specifically, the Office Action states the placement of the absorbent material on the *inner surface* of the inner lining is not disclosed. The Office Action acknowledges the specification (10:6-8) discloses the absorbent material may be secured to the inner layer of the claimed bag. The Office Action further correctly notes that the specification does not specifically disclose which surface (inner or outer) of the inner layer the absorbent material is secured to. The Office Action thus concludes one of ordinary skill would not know which surface – inner or outer – of the inner layer one of skill would use to secure the absorbent material. Applicants respectfully traverse.

Applicants concur that the specification does not specifically call out which surface (inner or outer) of the inner layer the absorbent material is secured to. However, Applicants respectfully submit that the specification, read as a whole, would lead one of ordinary skill to the conclusion there is only one surface – the inner surface – to which the absorbent material would be secured.

It is Hornbook law that the specification is directed to one of ordinary skill in the art. MPEP 2164.01. Further, the courts have established an *objective* standard for determining compliance with the written description requirement, whether the application reasonably conveys that the inventor had possession of the claimed subject matter at the time of filing. MPEP 2163.02 (citations omitted).

In this case, it is undisputed that the application teaches joining of the absorbent material to the inner layer. The only question is which surface of the inner layer – the outer surface or the inner surface – of the inner layer is taught.¹

The Specification Teaches Away From Placing The Absorbent On The Outer Surface Of The Inner Layer.

The specification (page 7, first para.) teaches that the layers of the bag may be provided from any material, so that the bag is liquid impervious (to contain the urine). This paragraph further teaches that in a preferred embodiment, a laminate may be formed from a nonwoven and film. Placing the absorbent material on the outer surface of the inner layer traps the absorbent between the plies, preventing a laminate from being formed.

¹ See Interview Summary of the telephonic interview of October 22, 2003 with Examiner Anderson.

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The specification (page 8, fourth para.) also teaches three layer laminate structures. The specification teaches a laminate sequence involving two nonwoven layers and a film, where the film is specifically said to be "interposed between the two nonwoven layers." Placing the absorbent on the outer surface of the inner layer would, again, prevent the disclosed laminate from being formed.

The specification (page 8, last para.) further teaches that the nonwoven layer may be treated to be impervious. If the inner layer is nonwoven, as specifically taught by the specification (page 7, first full para.), and made hydrophobic as taught, this would defeat the purpose of placing the absorbent material on the outer surface of the inner layer. Specifically, if the nonwoven layer was "treated with coatings of liquid impervious materials" as taught by the instant specification (page 8, last para.), the urine would never reach the absorbent material – destroying its purpose.

One of skill reading the specification would be led away from joining (or even disposing) the absorbent material to the outer surface of the inner layer. There is no teaching or suggestion to do so.

The Specification Teaches Placing The Absorbent Material On The Inner Surface Of The Inner Layer.

One of skill reading the instant specification would understand the purpose of the claimed device is to "entrap and immediately contain urine" (page 1, second para.). One of skill would further understand that this is accomplished by entrapping the urine in the bag. Urinary management devices which do not have storage capacity (as provided by the absorbent material) are not within the scope of the present invention (page 5, para. bridging from page 4). Accordingly, the only way to achieve a storage device is to place the absorbent material on the inner surface of the inner lining. One of skill would need to read no further to understand which surface the absorbent material would be secured to.

However, one of skill who did read further would recognize that page 6, fourth para., specifically teaches that the bag is designed to contain "any entrapped material" such as the bodily fluids and other materials entrapped or contained by the absorbent material. This is only accomplished by securing the absorbent material to the inner surface of the inner layer.

Even more compelling, one of skill reading the specification (page 10, lines 5-6) would see that the absorbent material "may be loosely arranged within the bag (11) or may be secured to the inner layer of the bag (11)" *Id.* One of skill would understand that the absorbent material that

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is "within the bag" will remain within the bag whether it is "loosely arranged" or alternatively "secured to" the inner layer. In the alternative embodiment, the absorbent material is secured to the inner surface of the inner layer.² One of skill would not reverse the arrangement specifically taught to be "within the bag" simply because it was not secured thereto. The specification specifically and particularly teaches two alternatives within the bag – one alternative within the bag being loosely arranged – the other alternative within the bag being secured thereto. In *either* embodiment, the absorbent material is disposed on the inner surface of the inner layer of the bag.

Finally, one of skill is allowed to rely upon ordinary skill in the art in reading and interpreting the specification. Here, literally decades of the prior art have taught the purpose of absorbent material is to contain urine. If the absorbent material were placed on the outer surface of the inner layer, as suggested by the Office Action, this entire purpose would be defeated and the article would not serve its intended purpose.

Accordingly, Applicants respectfully submit that 1) given the teachings of the specification away from placing the absorbent material on the outer surface of the inner layer, 2) given the specific teachings and purpose set forth in the disclosure to place the absorbent material on the inner surface of the outer layer, and 3) the knowledge attributed to one of ordinary skill of how to make urine management devices, the only interpretation of the disclosure which makes sense is that set forth in the instant claims – that the absorbent material is secured to the inner surface of the inner layer. The objective standard set forth in MPEP 2163.02 is satisfied.

Accordingly, Applicants respectfully request that the rejection of Claims 1-6 and 10-11 under 35 USC §112 be withdrawn. Claim 12 is canceled hereunder without prejudice or disclaimer.

Claims 1-5 and 10 are rejected under 35 USC §102(b) over Schneider et al. (5,417,677). Claim 6 is rejected under 35 USC §103(a) over Schneider in view of Allen, Jr. (4,561,858). As agreed to during the Interview of October 6, 2003 with Examiner Anderson, the claims – interpreted as having the absorbent material secured to the inner surface of the inner liner – are structurally distinguishable over Schneider. As Applicants have previously argued (see Response to Office Action Dated Dec. 4, 2002), the Schneider et al. absorbent does not contact the body waste of the user and therefore cannot provide the benefits of the claimed invention. Instead, Schneider is aimed at disposal. Accordingly, Schneider does not anticipate the claimed invention

² This interpretation is consistent with the introductory language of that paragraph (10:4) which states the absorbent material is placed "in the bag," i.e., on the inner surface of the inner layer.

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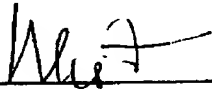
when properly construed with the limitation that the absorbent material is secured to the inner surface of the inner layer.

~~Claim 1 is rejected for double patenting over commonly assigned U.S. Pat. No. 6,491,673. A Terminal Disclaimer is enclosed herewith, overcoming this rejection.~~

The Examiner is respectfully requested to reconsider and allow all claims remaining in the application.

Respectfully submitted,

By


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